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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,336	04/19/2004	Shunsuke Uozumi	7378/84013	9567

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EXAMINER	
FEELY, MICHAEL J	

ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/826,336	UOZUMI, SHUNSUKE	
	Examiner	Art Unit	
	Michael J. Feely	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Pending Claims

Claims 1-12 are pending.

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 4, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Feinberg (US Pat. No. 3,711,390).

Regarding claims 1, 2, 4, 7, and 8, Feinberg discloses: ***(1)*** a cationically polymerizable composition (column 2, lines 23-43), comprising at least a cationically polymerizable compound (column 2, lines 23-43), a cationic-polymerization initiator (column 2, lines 23-43), and a nitrogen-containing alicyclic compound (column 2, lines 23-43; column 8, lines 34-55); ***(2)*** wherein said cationically polymerizable compound comprises at least an alicyclic epoxy compound and an oxetane compound (column 3, lines 17-39); ***(4)*** wherein said nitrogen-containing alicyclic compound comprises two or more amine nitrogen atoms as constituent

elements of one ring thereof (column 8, lines 34-55); *(7)* wherein said nitrogen-containing alicyclic compound is present in an amount of from 0.001 to 1% by weight of the total amount of said composition (column 10, lines 32-50); and *(8)* wherein said composition is of activation energy beam-curable type (column 9, lines 29-42).

4. Claims 1, 2, 4, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Feinberg (US Pat. No. 3,817,850).

Regarding claims 1, 2, 4, 7, and 8, Feinberg discloses: *(1)* a cationically polymerizable composition (column 2, lines 26-50), comprising at least a cationically polymerizable compound (column 2, lines 26-50), a cationic-polymerization initiator (column 2, lines 26-50), and a nitrogen-containing alicyclic compound (column 2, lines 26-50; column 9, lines 23-45); *(2)* wherein said cationically polymerizable compound comprises at least an alicyclic epoxy compound and an oxetane compound (column 3, lines 25-46); *(4)* wherein said nitrogen-containing alicyclic compound comprises two or more amine nitrogen atoms as constituent elements of one ring thereof (column 9, lines 23-45); *(7)* wherein said nitrogen-containing alicyclic compound is present in an amount of from 0.001 to 1% by weight of the total amount of said composition (column 11, lines 20-39); and *(8)* wherein said composition is of activation energy beam-curable type (column 10, lines 18-31).

5. Claims 1, 2, 4, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Schlesinger (US Pat. No. 3,835,003).

Regarding claims 1, 2, 4, 7, and 8, Schlesinger discloses: ***(1)*** a cationically polymerizable composition (column 2, lines 39-50), comprising at least a cationically polymerizable compound (column 2, lines 39-50), a cationic-polymerization initiator (column 2, lines 39-50), and a nitrogen-containing alicyclic compound (column 8, line 70 through column 9, line 17); ***(2)*** wherein said cationically polymerizable compound comprises at least an alicyclic epoxy compound and an oxetane compound (column 2, lines 39-50); ***(4)*** wherein said nitrogen-containing alicyclic compound comprises two or more amine nitrogen atoms as constituent elements of one ring thereof (column 8, line 70 through column 9, line 17); ***(7)*** wherein said nitrogen-containing alicyclic compound is present in an amount of from 0.001 to 1% by weight of the total amount of said composition (column 8, line 70 through column 9, line 17); and ***(8)*** wherein said composition is of activation energy beam-curable type (column 7, line 72 through column 8, line 23).

6. Claims 1-3, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Schlesinger (US Pat. No. 3,951,769).

Regarding claims 1-3, 7, and 8, Schlesinger discloses: ***(1)*** a cationically polymerizable composition (column 2, lines 5-27), comprising at least a cationically polymerizable compound (column 2, lines 5-27), a cationic-polymerization initiator (column 2, lines 5-27), and a nitrogen-containing alicyclic compound (column 2, lines 5-27; column 5, line 45 through column 7, line 38); ***(2)*** wherein said cationically polymerizable compound comprises at least an alicyclic epoxy compound and an oxetane compound (column 2, lines 30-57); ***(3)*** wherein said nitrogen-containing alicyclic compound comprises a secondary amine nitrogen atom as a constituent

element of its ring (column 5, line 45 through column 7, line 38); *(7)* wherein said nitrogen-containing alicyclic compound is present in an amount of from 0.001 to 1% by weight of the total amount of said composition (column 9, lines 8-15 and 41-59); and *(8)* wherein said composition is of activation energy beam-curable type (column 8, lines 25-37).

7. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Baumann et al. (US Pat. No. 5,296,567).

Regarding claims 1-8, Baumann et al. disclose: *(1)* a cationically polymerizable composition (column 3, lines 4-32), comprising at least a cationically polymerizable compound (column 3, lines 4-32), a cationic-polymerization initiator (column 3, lines 4-32), and a nitrogen-containing alicyclic compound (column 3, lines 4-32; column 3, line 61 through column 4, line 5); *(2)* wherein said cationically polymerizable compound comprises at least an alicyclic epoxy compound and an oxetane compound (column 6, lines 19-50); *(3)* wherein said nitrogen-containing alicyclic compound comprises a secondary amine nitrogen atom as a constituent element of its ring (column 3, line 61 through column 4, line 5); *(4)* wherein said nitrogen-containing alicyclic compound comprises two or more amine nitrogen atoms as constituent elements of one ring thereof (column 3, line 61 through column 4, line 5); *(5)* wherein said nitrogen-containing compound comprises two or more secondary amine nitrogen atoms as constituent elements of one ring thereof (column 3, line 61 through column 4, line 5); *(6)* wherein said nitrogen-containing alicyclic compound is selected from the group consisting of pyrazolidine, piperazine, homopiperazine and derivatives thereof (column 3, line 61 through column 4, line 5); *(7)* wherein said nitrogen-containing alicyclic compound is present in an

amount of from 0.001 to 1% by weight of the total amount of said composition (column 5, lines 53-68); and ***(8)*** wherein said composition is of activation energy beam-curable type (column 3, lines 4-32: *inherent characteristic*).

8. Claims 1 and 3-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Morijiri et al. (US Pat. No. 6,204,311).

Regarding claims 1 and 3-8, Morijiri et al. disclose: ***(1)*** a cationically polymerizable composition (column 2, lines 10-48; column 6, lines 18-21 and 53-58), comprising at least a cationically polymerizable compound (column 2, lines 10-48; column 6, lines 18-21 and 53-58), a cationic-polymerization initiator (column 2, lines 10-48; column 6, lines 18-21 and 53-58), and a nitrogen-containing alicyclic compound (column 2, lines 10-48; column 6, lines 18-21 and 53-58); ***(3)*** wherein said nitrogen-containing alicyclic compound comprises a secondary amine nitrogen atom as a constituent element of its ring (column 8, lines 24-54; column 9, lines 45-49); ***(4)*** wherein said nitrogen-containing alicyclic compound comprises two or more amine nitrogen atoms as constituent elements of one ring thereof (column 8, lines 24-54; column 9, lines 45-49); ***(5)*** wherein said nitrogen-containing compound comprises two or more secondary amine nitrogen atoms as constituent elements of one ring thereof (column 8, lines 24-54; column 9, lines 45-49); ***(6)*** wherein said nitrogen-containing alicyclic compound is selected from the group consisting of pyrazolidine, piperazine, homopiperazine and derivatives thereof (column 8, lines 24-54; column 9, lines 45-49); ***(7)*** wherein said nitrogen-containing alicyclic compound is present in an amount of from 0.001 to 1% by weight of the total amount of said composition

(column 8, lines 24-54; column 9, lines 45-49); and ***(8)*** wherein said composition is of activation energy beam-curable type (column 6, lines 18-21 and 53-58: *inherent characteristic*).

Claim Rejections - 35 USC § 102/103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 9-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over any of the following references: Feinberg (US Pat. No. 3,711,390); Feinberg (US Pat. No. 3,817,850); Schlesinger (US Pat. No. 3,835,003); Schlesinger (US Pat. No. 3,951,769); and Baumann et al. (US Pat. No. 5,296,567).

Regarding claims 9-12, the teachings of the above-mentioned references are as set forth above and incorporated herein. All of the above-mentioned references include a colorant: Feinberg (US Pat. No. 3,711,390) *see column 11, lines 18-21*; Feinberg (US Pat. No. 3,817,850) *see column 12, lines 5-8*; Schlesinger (US Pat. No. 3,835,003) *see column 8, lines 62-65*; Schlesinger (US Pat. No. 3,951,769) *see column 10, lines 30-33*; and Baumann et al. (US Pat. No. 5,296,567) *see column 9, lines 38-41*. The prior art references satisfy all of the material and chemical limitations set forth in claims 9-12; however none of these references explicitly disclose an *ink*.

In light of this, it has been found that, "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are

inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present – *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). *Please refer to MPEP 2112.01.*

Therefore, it appears that the *ink* limitations set forth in claims 9-12 would have been inherently satisfied by the above-mentioned prior art references because the prior art references satisfy all of the material and chemical limitations set forth in the claims.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Feely whose telephone number is 571-272-1086. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael J. Feely
Primary Examiner
Art Unit 1712

September 25, 2006

MICHAEL FEELY
PRIMARY EXAMINER